

This Opinion is Not a
Precedent of the TTAB

Mailed: June 22, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
In re Pen Pal, LLC

—
Serial No. 90730679

—
Robert R. Lech of Lech Law, LLC, for Pen Pal, LLC.

Tarah Hardy Ludlow, Trademark Examining Attorney, Law Office 110,
Chris Pedersen, Managing Attorney.

—
Before Zervas, Hudis, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

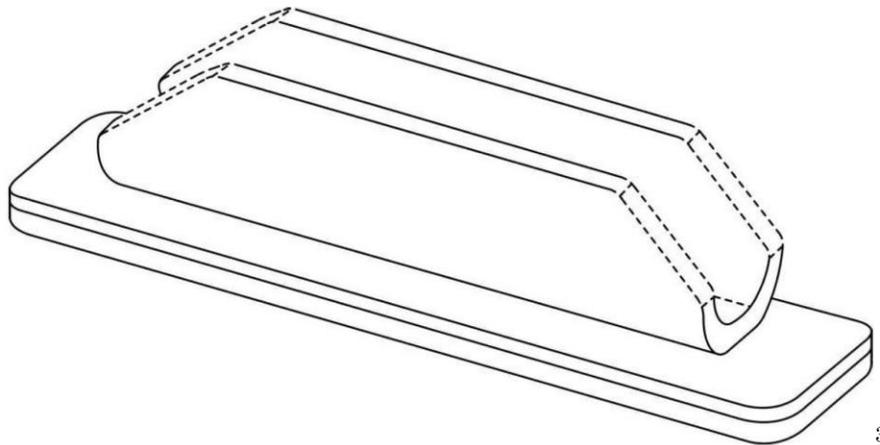
Pen Pal, LLC (“Applicant”) seeks registration on the Principal Register of a three-dimensional configuration mark for “Pen holders; Pen and pencil holders; Pen or pencil holders” (“Applicant’s Goods”), in International Class 16.¹

¹ Application Serial No. 90730673 was filed on May 24, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and first use in commerce since at least as early as July 18, 2011.

Citations to the appeal record are from the publicly available documents in TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable. All citations to prosecution history documents contained in the

In her first Office Action, the Trademark Examining Attorney refused registration of Applicant's mark on the grounds of functionality under Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5), and on the grounds that the mark constitutes nondistinctive product design under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127. The Examining Attorney also required Applicant to provide an accurate description of the mark. *See* Trademark Rules 2.37, 2.52(b)(2) and (b)(4), 37 C.F.R. §§ 2.37, 2.52(b)(2) and (b)(4).

In response, Applicant argued against the functionality and nondistinctive product design refusals and presented evidence in support of acquired distinctiveness.² Applicant also amended the drawing of its mark, so that it now appears as shown below ("Applicant's Mark"):



Applicant additionally amended the description of its mark as follows:

The mark consists of a three-dimensional configuration of specific design features of a pen or pencil holder; The

Trademark Status and Document Retrieval (TSDR) database are to the downloadable .pdf versions of the documents.

² Aug. 3, 2022 Response to Office Action ("ROA") at 132-42.

³ Aug. 3, 2022 Amended Drawing at 1.

applied-for mark comprises the exterior surface of an upper portion of the holder; The applied-for mark further comprises the rectangular base of the holder; The applied-for mark does not comprise the interior surface of the upper portion of the holder or the end portions of the slot where a pen or pencil may be inserted into the holder.⁴

In the August 18, 2022 Final Office Action, the Examining Attorney accepted Applicant's evidence of acquired distinctiveness and withdrew the nondistinctive product design refusal, but maintained the functionality refusal. The Examining Attorney also maintained the requirement for a more accurate description of the mark and recommended the following description (which, prior to its appeal, Applicant did not accept – such that the description of the mark in the Application currently reads as quoted above).⁵

Applicant then filed an appeal to this Board, which has been briefed. In light of the current description of the mark, we affirm the refusal to register Applicant's Mark based on functionality. We also affirm the Examining Attorney's requirement for a more accurate description of the mark.

I. Background and Summary of Record

Applicant submitted the following specimen of use in connection with the Application:

⁴ Aug. 3, 2022 ROA at 1 [hereinafter "Amended Description"].

⁵ Aug. 18, 2022 Final Office Action at 6.

5/24/2021 Classic Pen Pal

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search

Classic Pen Pal

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Classic Pen Pal



LARGER PHOTO

Like 2

Alternative Views:



Quantity Based Pricing:

25-49	: \$1.18
50-74	: \$1.09
75-99	: \$1.03
100-199	: \$0.98
200-499	: \$0.93
500-999	: \$0.88
1000-1999	: \$0.83
2000-3999	: \$0.78
4000-6999	: \$0.73
7000-9999	: \$0.68
10000+	: \$0.65

Our Price: **\$1.18**
(Minimum order): 25

This item qualifies for FREE SHIPPING!

Availability: Usually Ships in 24 to 48 Hours
Product Code: CLASSIC-1

Choose your options:

Click to view another Color



Color: **Black** ▾

Qty: [add to cart](#)

[★ Add to Wish List](#)

[VIEW QUANTITY DISCOUNTS](#)

Description [Technical Specs](#)

The classic Pen Pal holds a variety of pen shapes and sizes. The largest pen size the classic Pen Pal can hold is a standard sharpie. The classic is great for almost anywhere. The strong adhesive can stick to most surfaces and provides a vice-like grip to the surface ensuring the Pen Pal will not come loose.

Features

- Adhesive backing sticks to most surfaces
- Holds up to a regular sized sharpie securely
- Provides a fix location for pens and pencils
- Pen Pal's design was perfected to hold a pen securely while at the same time allowing the pen to be easily inserted and removed from the holder

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⁶ Specimen, App. Ser. No. 90730679, at 7 (cropped image of page 1 at <https://store.penpalholder.com/product-p/classic-1.htm>).



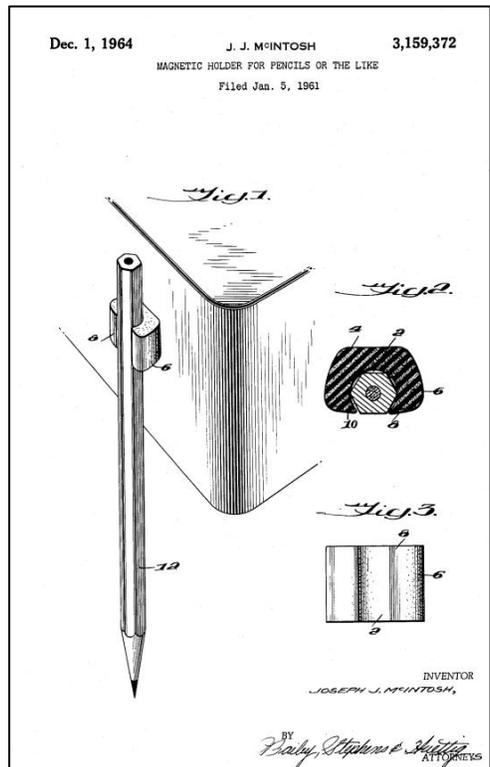
Description	Technical Specs
The classic Pen Pal holds a variety of pen shapes and sizes. The largest pen size the classic Pen Pal can hold is a standard sharpie. The classic is great for almost anywhere. The strong adhesive can stick to most surfaces and provides a vice-like grip to the surface ensuring the Pen Pal will not come loose.	

- | Features |
|--|
| <ul style="list-style-type: none">• -Adhesive backing sticks to most surfaces-Holds up to a regular sized sharpie securely-Provides a fix location for pens and pencils-Pen Pal's design was perfected to hold a pen securely while at the same time allowing the pen to be easily inserted and removed from the holder |

In Applicant’s specimen (relevant portions of which are enlarged and reproduced immediately above), the “Classic Pen Pal” product is described, in relevant part, as having a “strong adhesive [that] can stick to most surfaces and provides a vice-like grip to the surface ensuring the Pen Pal will not come loose,” and a “design [that] was perfected to hold a pen securely while at the same time allowing the pen to be easily inserted and removed from the holder.”

In support of the first Office Action refusal, the Examining Attorney submitted the following evidence:

1. A screen shot from the Google Patents search engine of U.S. Patent No. 3,159,372 (the '372 Patent), "Magnetic Holder For Pencils Or The Like,"⁷ the drawing for which is reproduced below.



⁷ Feb. 3, 2022 Office Action at 8 (located at <https://patents.google.com/patent/US3159372?q=pencil+holder+plastic>). In addition to providing an embedded link to the Google Patents page for the '372 Patent, the Examining Attorney entered into the record an image of the drawing page that was significantly reduced in size. The Examining Attorney quotes language from Claim 1 in her brief. Generally, providing a website address or hyperlink to Internet materials that are illegible but included in the record is insufficient to make such materials of record. See *In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (citing *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017)); *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013). In addition, the Board does not take judicial notice of patent application files and registration records. See *In re Jimmy Moore, LLC*, 119 USPQ2d 1764, 1767-68 (TTAB 2016) (denied request for judicial notice of patent, saying "the Board does not take judicial notice of records residing in the Patent and Trademark Office"). Applicant objected to the admissibility of the '372 Patent not on procedural grounds, but on the grounds that Applicant's Mark (and corresponding product) "is completely devoid of any magnet." Applicant's Brief, 4 TTABVue 11-12. We will consider the '372 Patent for whatever probative value it is worth.

⁸ Feb. 3, 2022 Office Action at 8.

Claim 1 of the '372 Patent reads as follows:

A magnetic holder for a slender elongated article comprising a body of magnetized rubber-like material having a substantially flat side for engagement with a ferrous metal surface and having spaced wings projecting away from the flat side with their free ends inwardly turned towards each other to form between the wings a generally cylindrical opening of a size and shape to engage the article frictionally and resiliently, the longitudinal axis of the opening extending substantially parallel to the plane of the flat side, the free ends of the wings being spaced apart to provide a slot there between.

and

2. A screen shot of Applicant's web page showing Applicant's Goods.⁹

In its response to the first Office Action, Applicant made the following evidence of record:

1. The amended drawing of Applicant's Mark, shown above;¹⁰
2. Applicant's design patent no. D617,382, "Writing Utensil Holder" (the '382 Patent);¹¹
3. Applicant's design patent no. D640,743, "Writing Utensil Holder" (the '743 Patent);¹²
4. Applicant's design patent no. D641,414, "Writing Utensil Holder" (the '414 Patent);¹³

⁹ *Id.* at 9 (located at <http://www.penpalholder.com>).

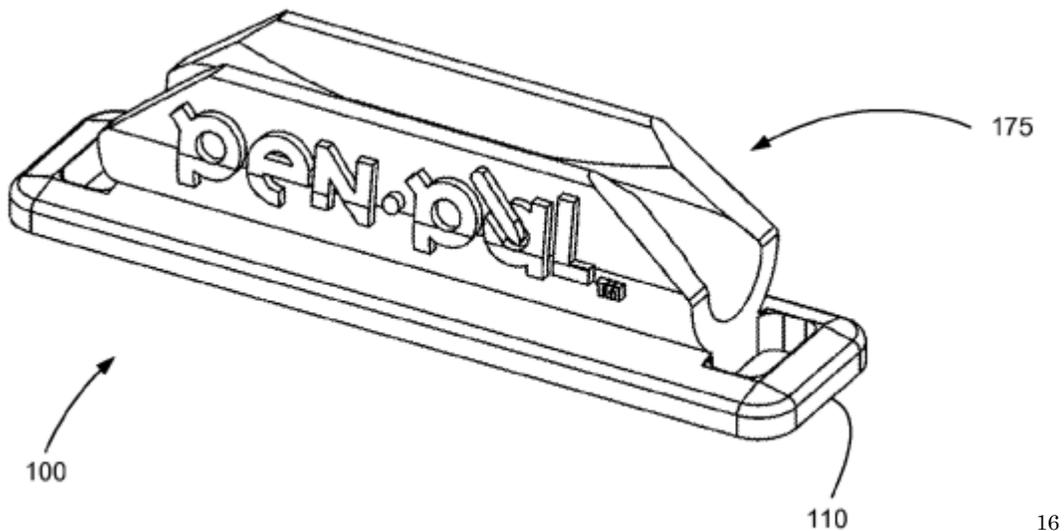
¹⁰ Aug. 3, 2022 ROA at 11, 137 (Ex. A).

¹¹ *Id.* at 13-16 (Ex. B).

¹² *Id.* at 17-20 (Ex. B).

¹³ *Id.* at 21-24 (Ex. B).

5. Applicant's design patent no. D665,449, "Writing Utensil Holder" (the '449 Patent);¹⁴
6. The file wrapper for Applicant's abandoned utility patent application no. 12/692,816¹⁵ ("Writing Utensil Holder") (the '816 Application). Figure 1 of the application is reproduced below.



The '816 Application states:

Background: Prior art pen holders are typically designed to fit one size pen or pens having diameters within a small range. A need therefore exists for a pen holder which can accommodate writing utensils within a wide range of diameters. Further, a need exists for a holder which is compact, allowing it to be mounted nearly anywhere a pen is needed. Yet another need exists for a pen holder which can be attached to a ribbon, lace or lanyard.¹⁷

Abstract: A holder for holding a writing utensil is disclosed. In one embodiment, the holder comprises a base and a grip. The grip is

¹⁴ *Id.* at 25-29 (Ex. B).

¹⁵ Aug. 3, 2022 ROA at 30-128 (Ex. B).

¹⁶ *Id.* at 121 (cropped image).

¹⁷ *Id.* at 109-110.

generally axially aligned with and connected to the base. The base and the grip form an indentation along an axial line of surface intersection. The grip comprises an interior wall defining a generally axial sleeve. The grip further comprises a first jaw and a second jaw. Each jaw comprises a tapered end, and the tapered ends define an axial slot. The jaws flex to receive and grip a generally cylindrical utensil inserted through the tapered axial slot into the axial sleeve.¹⁸

and

7. The “Declaration of Edward G. Guirlinger,” Applicant’s President.¹⁹

The Examining Attorney made the following evidence of record with the Final Office Action:

1. A copy of the ’816 Application, “Writing Utensil Holder,” from the Google Patents search engine;²⁰ and
2. Pages from the mypilotstore.com website advertising Applicant’s “Pen-Pal Rubber Pen Holder.”

II. Applicable Law

Section 2(e)(5) of the Trademark Act prohibits registration of “a mark which . . . comprises any matter that, as a whole, is functional.” 15 U.S.C. § 1052(e)(5). “A product design or a product feature is considered functional in a utilitarian²¹ sense if:

¹⁸ *Id.* at 120.

¹⁹ *Id.* at 130-31, 141-42 (Ex. C). Paragraph nine of the declaration includes inactive deep links to pages featuring “products employing the Pen Pal trade dress” in unsolicited media posts, but Applicant did not attach as exhibits to the declaration printed copies of the pages located at the deep link addresses. Providing a website address or inactive deep link to Internet materials is insufficient to make such materials of record. *See In re ADCO Indus.-Techs.*, 2020 USPQ2d 53786, at *2 (citing *In re Olin Corp.*, 124 USPQ2d at 1332 n.15); *In re Powermat Inc.*, 105 USPQ2d at 1791.

²⁰ Aug. 18, 2022 Final Office Action at 8-16.

²¹ In contrast to “utilitarian functionality,” under “aesthetic functionality” we consider whether “a design’s ‘aesthetic value’ lies in its ability to ‘confer a significant benefit that

(1) it is ‘essential to the use or purpose of the article,’ or (2) it ‘affects the cost or quality of the article.’” *In re MK Diamond Prods.*, 2020 USPQ2d 10882, at *5 (TTAB 2020) (quoting *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.10 (1982))).

Our determination of functionality is generally guided by the analysis first applied by the Court of Customs and Patent Appeals in *In re Morton-Norwich Prods.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982) (“*Morton-Norwich*”). In that case, the court outlined the following categories of evidence (the “*Morton-Norwich* factors”) as being helpful in determining whether a particular design is functional:

- (1) The existence of a utility patent disclosing the utilitarian advantages of the design;
 - (2) Advertising materials in which the originator of the design touts the design’s utilitarian advantages;
 - (3) The availability to competitors of functionally equivalent designs;
- and
- (4) Facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

Morton-Norwich, 213 USPQ at 15-16; *see also Valu Eng’g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002); *Kohler Co. v. Honda Giken*

cannot practically be duplicated by the use of alternative designs....’ The ultimate test of aesthetic functionality ... is whether the recognition of trademark rights would significantly hinder competition.” *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1165 (1995) (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17, Comment *c*, pp. 175-76 (1993)). We direct our analysis and discussion to the concept of utilitarian functionality, since aesthetic functionality is not at issue in this appeal.

Kogyo K.K., 125 USPQ2d 1468, 1489 (TTAB 2017); *Poly-Am., L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1513 (TTAB 2017); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456 (TTAB 2017). Similarly, persuasive evidence of functionality is an abandoned utility patent application with statements disclosing the utilitarian advantages of a product's design. *Valu Eng'g*, 61 USPQ2d at 1429 ("We agree with the Board that an abandoned patent application should be considered under the first *Morton-Norwich* factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance.") (citing generally *TrafFix*).

In considering the product configuration (or "product design") mark as a whole, the U.S. Court of Appeals for the Federal Circuit has recognized that the initial analysis may be of the separate features of the involved configuration, followed by consideration of the entire design. *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) ("*Becton, Dickinson*") ("[O]ne object of the *Morton-Norwich* inquiry is to weigh the elements of a mark against one another to develop an understanding of whether the mark as a whole is essentially functional and thus non-registrable."); *In re R. M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1, 2 (Fed. Cir. 1984). In addition to the numbered claims, the Board may also consider the disclosures in the written description of the patent, the drawings and the abstract of the patent, and any other evidence relevant to the functionality of the proposed mark at issue. See *McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559,

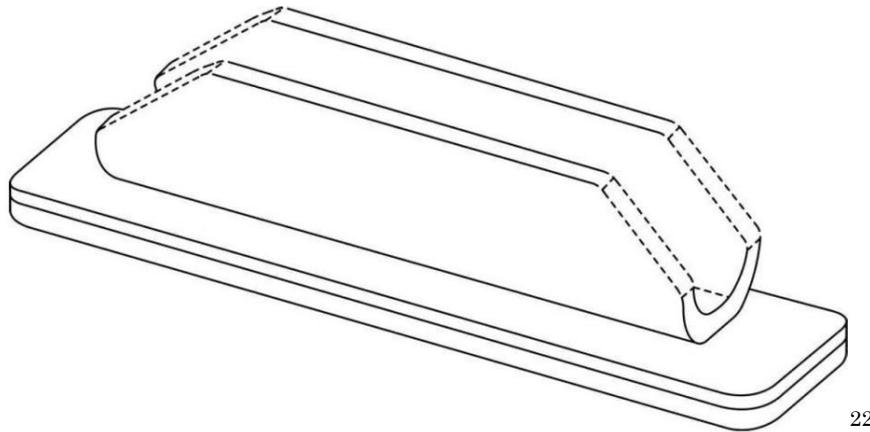
at *40 (TTAB 2021) (considering the numbered claims, disclosures, drawings, and abstract); *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1046-47 (TTAB 2013) (considering the background and summary sections of a patent, product information from the Internet, declarations, and other evidence in a patent relevant to functionality); *In re Becton, Dickinson* 102 USPQ2d at 1377 (considering the statements in the patent specification); *see also In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1431-32 (TTAB 2016) (indicating that evidence of functionality in a patent is not limited to language in the claims themselves).

The *Morton-Norwich* factors “are not exclusive, however, for functionality ‘depends upon the totality of the evidence.’” *In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) (quoting *Valu Eng’g*, 61 USPQ2d at 1424). Indeed, in any given case, some of the factors may not be necessarily relevant to a finding of functionality, nor will they have to weigh in favor of functionality to support a finding of functionality. *In re Change Wind*, 123 USPQ2d at 1456; *In re Heatcon*, 116 USPQ2d at 1370; *cf. Poly-Am.*, 124 USPQ2d at 1519 (“Petitioner need not present evidence fitting within all four categories in *Morton-Norwich*.”). Ultimately, the determination of functionality is a question of fact and depends on the totality of the evidence presented in each particular case. *See, e.g., Valu Eng’g*, 61 USPQ2d at 1424; *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009).

III. Analysis

A. Applicant's Abandoned Utility Patent Application

As noted, the record includes Applicant's abandoned '816 utility patent application. An abandoned utility patent application, its prosecution history, as well as statements in the abandoned application which refer to the utilitarian advantages of a product's design, are all persuasive evidence of functionality. *Valu Eng'g*, 61 USPQ2d at 1429. For ease of reference, the Amended Drawing of and Amended Description for Applicant's Mark are reproduced below:



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The mark consists of a three-dimensional configuration of specific design features of a pen or pencil holder; The applied-for mark comprises the exterior surface of an upper portion of the holder; The applied-for mark further comprises the rectangular base of the holder; The applied-for mark does not comprise the interior surface of the upper portion of the holder or the end portions of the slot where a pen or pencil may be inserted into the holder.²³

Applicant asserts that the substance of the claims in its abandoned utility patent application are either expressly excluded from the description of its mark, or just not

²² Aug. 3, 2022 Amended Drawing at 1.

²³ Aug. 3, 2022 ROA at 1.

embodied in the applied-for mark. (4 TTABVUE 10-11). Applicant argues that Claims 2, 4, 5, 6, and 7 of the '816 Application do not claim any utilitarian advantages of Applicant's Mark. (4 TTABVUE 10-11). Claim 1, the first independent claim²⁴ of the '816 Application, reads as follows:

A holder comprising: a base; a grip generally axially aligned with and connected to the base, the base and the grip forming an indentation along an axial line of surface intersection, the grip comprising an interior wall defining a generally axial sleeve, the grip comprising a first jaw and a second jaw, each jaw comprising a tapered end, the tapered ends defining an axial slot; and whereby the jaws flex to receive and grip a generally cylindrical utensil inserted through the tapered axial slot into the axial sleeve.²⁵

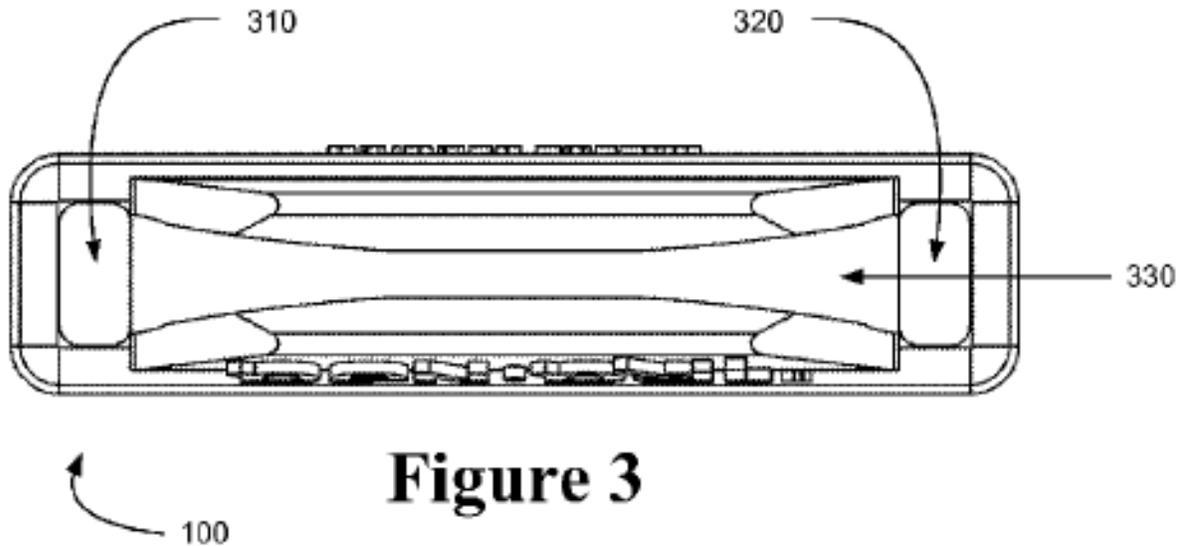
Claims 2, 4, 5, 6, and 7 depend on Claim 1.

As to Claim 2, Applicant argues that the two apertures (refs. 310 and 320) at the ends of the example holder ("holder") are not present in Applicant's Mark at all. (4 TTABVUE 10). Claim 2 states, "[t]he holder of claim 1 wherein the base forms a first aperture disposed at a first end of the holder and a second aperture disposed at a second end of the holder."²⁶ Reproduced below is a drawing of the "top view" of the holder, as shown in Figure 3 of the '816 Application:

²⁴ A "patent claim" is "a formal statement describing the novel features of an invention and defining the scope of the patent's protection." BLACK'S LAW DICTIONARY (11th ed. 2019). An "independent claim" is "a patent claim that does not refer to any other claim." *Id.* Claims 2, 4, 5, 6, and 7 are dependent claims of Claim 1. A "dependent claim" is "a patent claim that refers to and further limits another claim or set of claims in the same patent application." *Id.* The Board may take judicial notice of dictionary definitions which exist in printed format or that have regular fixed editions. *In re N. Am. Free Trade Ass'n*, 43 USPQ2d 1282, 1285 n.6 (TTAB 1997) (Board took judicial notice of a definition from BLACK'S LAW DICTIONARY).

²⁵ Aug. 3, 2022 ROA at 116.

²⁶ *Id.*



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As to Claim 4, Applicant argues that the tapered ends (refs. 155 and 165; see Fig. 2 below) are excluded from Applicant’s Mark. (4 TTABVUE 10). Claim 4 states, “[t]he holder of claim 1 wherein the [sic] each tapered end comprises an inner thickness and a peripheral thickness, and the inner thickness is greater than the peripheral thickness.”²⁸ Reproduced below is a drawing of the side view of the holder, as shown in Figure 2 of the ’816 Application:

²⁷ *Id.* at 122. References (“refs.”) 310 and 320 are the “aperture[s],” reference (“ref.”) 330 is the “axial sleeve,” and reference 100 is for the “Example holder” generally.

²⁸ *Id.* at 116.

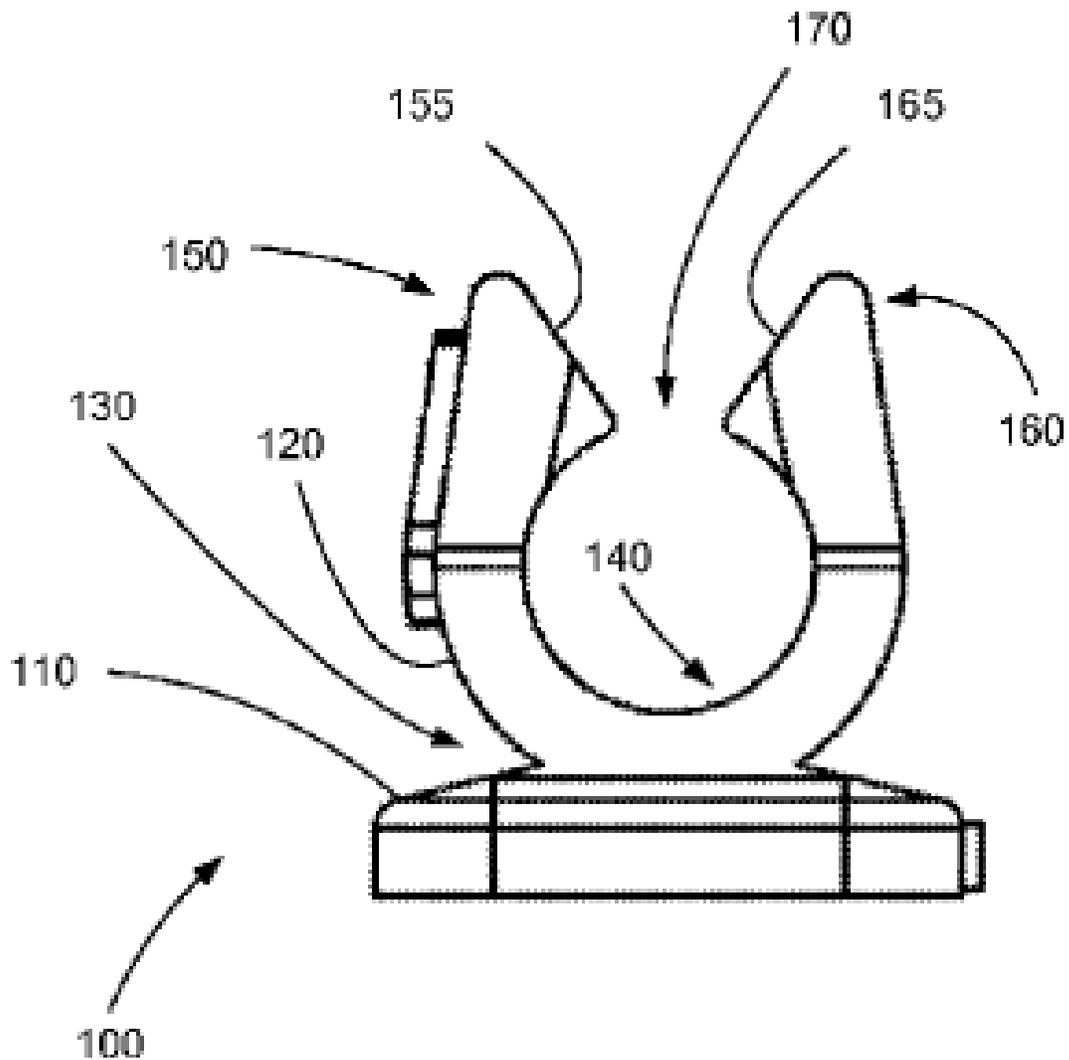
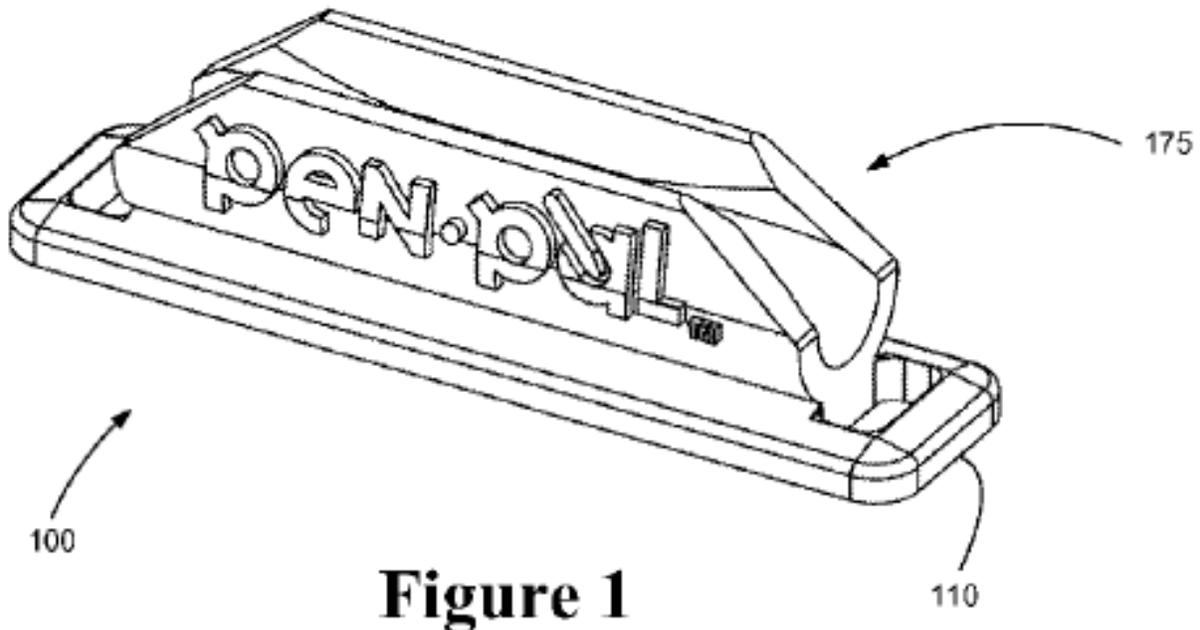


Figure 2

²⁹ Aug. 3, 2022 ROA at 121. Relevant to our analysis, ref. 120 is the “grip,” ref. 150 is the “first jaw,” ref. 160 is the “second jaw,” ref. 140 is the “interior wall,” ref. 155 is the “first tapered end,” ref. 165 is the “second tapered end,” and ref. 170 is the “axial slot.” Ref. 130 is the “indentation.”

Claim 5 states, “[t]he holder of claim 1 wherein each jaw comprises at least one tapered shoulder.”³⁰ Applicant argues that the tapered shoulder(s) (ref. 175) are also excluded from Applicant’s Mark. (4 TTABVUE 11). A drawing of the “perspective view” of the holder, as shown in Figure 1 of the ’816 Application, is reproduced below:



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Claim 6 states, “[t]he holder of claim 1 wherein the base (ref. 110) comprises a bottom, and the holder further comprises an adhesive applied to the bottom of the holder.”³² Applicant asserts that neither the bottom of the holder nor the adhesive applied to it are included in Applicant’s Mark. (4 TTABVUE 11). Applicant makes a similar argument as to Claim 7: neither the bottom of the holder, nor the magnet applied to it, are included in Applicant’s Mark. (4 TTABVUE 11). Claim 7 states, “[t]he holder of claim 1 wherein the base defines a bottom, and the holder further

³⁰ *Id.* at 116.

³¹ *Id.* at 121.

³² *Id.* at 117.

comprises a magnet applied to the bottom of the holder.”³³ A drawing of the front view of the holder, as shown in Figure 4 of the ’816 Application, is reproduced below:

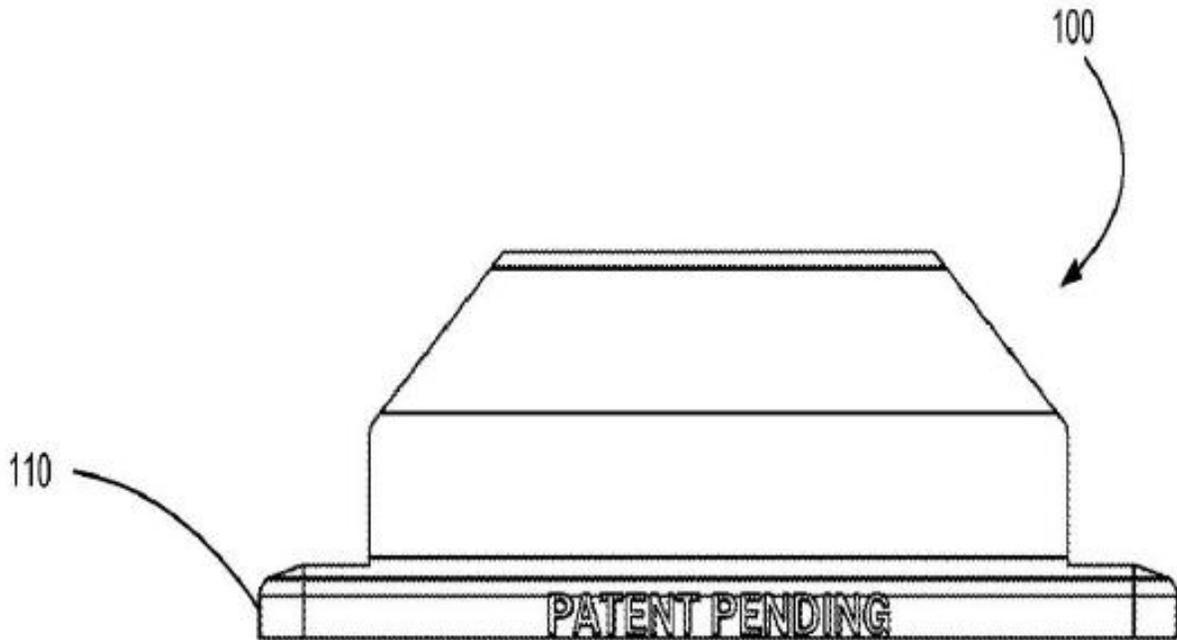


Figure 4

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Claims 2, 4, 5, 6, and 7 of the ’816 Application do not exactly read on³⁵ the Amended Description of Applicant’s Mark. But it is not required that “a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant’s assertion that an applied-for mark is not de jure

³³ *Id.*

³⁴ Aug. 3, 2022 ROA at 122.

³⁵ “Read on” is defined as “to contain all the same features of (a prior-art reference),” or “to describe an infringing product or process.” BLACK’S LAW DICTIONARY (11th ed. 2019).

functional.”³⁶ *Becton, Dickinson*, 102 USPQ2d at 1377. Where, as here, a utility patent application claims more than what is sought to be registered as a product design mark, that fact does not establish the non-functionality of the product design, if the utility patent application shows that the feature claimed as a trademark is an essential or integral part of the invention and has utilitarian advantages. *TrafFix*, 58 USPQ2d at 1007 (“Whether a utility patent has expired or there has been no utility patent at all, a product design which has a particular appearance may be ‘essential to the use or purpose of the article’ or ‘affects the cost or quality of the article.’”). *TrafFix* also teaches that statements in a patent’s specification illuminating the purpose served by a design may constitute equally strong evidence of functionality.” *Becton, Dickinson*, 102 USPQ2d at 1375 (citing *TrafFix*).

Moreover, where, as here, all or substantially all of an applicant’s overall design is dictated by the function it performs, it is functional. *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 370 (TTAB 1985) (configuration of whirlpool jets for bathtubs held functional because “the appearance of the ... body is adapted to the function it performs”).

Applicant seeks to register a product design that claims “the exterior surface of an upper portion of the [pen or pencil] holder” and “the rectangular base of the [pen or

³⁶ “[D]e facto functional means that the design of a product has a function, i.e., a bottle of any design holds fluid. De jure functionality, on the other hand, means that the product is in its particular shape because it works better in this shape.” *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994) (citations omitted). “This distinction is useful because the configuration of a product is not necessarily lacking in trademark significance because of ‘the mere *existence* of utility’; rather it should depend on ‘the degree of design utility.’” *In re R.M. Smith*, 222 USPQ at 3 (quoting *Morton-Norwich*, 213 USPQ at 14).

pencil] holder.” Integral to Claim 1 of the ’816 Application are the base and grip of the invention, as shown in Figures 2 (refs. 110 and 120) and 4 (ref. 110), above. Relevant text in the Background section of Applicant’s abandoned utility patent application discusses the “need ... for a pen holder which can accommodate writing utensils within a wide range of diameters,”³⁷ and “a need ... for a device that allows for easy insertion of the pen into the holder regardless of its diameter.”³⁸ Relevant portions of the Summary identify “a base and a grip” as being fundamental to the design of the pen holder.³⁹

Applicant argues that “any functionality of holding [a] pen is accomplished [by] using the contours of the inner surface which are expressly disclaimed...” (4 TTABVUE 12). But based on the text of the Background, Summary, and Claim 1, discussed above, we find that Applicant’s abandoned ’816 patent application discloses a utilitarian advantage of Applicant’s product design: specifically, the shape of the base (ref. 110) and the external surfaces of the jaws (or exterior upper surfaces) (refs. 150 and 160), all of which are integral parts of the holder’s main function to hold a pen (or other cylindrical instrument), regardless of its diameter, in place. Again, Applicant’s abandoned utility patent application need not precisely identify the specific features of Applicant’s product design mark; it is enough that the statements in the abandoned utility patent application show that features claimed by Applicant

³⁷ Aug. 3, 2022 ROA at 109.

³⁸ *Id.*

³⁹ *Id.* at 110.

as a trademark constitute essential or integral parts of the invention and offer a utilitarian advantage. *TrafFix*, 58 USPQ2d at 1007; *see also Becton, Dickinson*, 102 USPQ2d at 1375. Here, “the exterior surface of an upper portion of the holder” and “the rectangular base of the holder” constitute essential or integral parts of the invention and offer a utilitarian advantage, inasmuch as the rectangular base functions to keep the holder upright, and the exterior surfaces of the upper portions of the holder function to keep a writing instrument in the holder and not roll away from, or fall out of, the holder. Furthermore, Applicant’s overall design is dictated by the function it performs — holding a pen, pencil, or other cylindrical writing instrument. *In re Vico Prods. Mfg.*, 229 USPQ at 370. Thus, the first *Morton-Norwich* factor weighs in favor of a finding of utilitarian functionality.

B. Advertising Materials in which the Originator of the Design Touts the Design’s Utilitarian Advantages

The specimen — which is advertising — touts the utilitarian advantages of Applicant’s product design: “Pen Pal’s design was perfected to hold a pen securely while at the same time allowing the pen to be easily inserted and removed from the holder.”⁴⁰ Text from Applicant’s web page that touts the utilitarian advantages of Applicant’s product design also was made of record:

Pen Pal is a very simple product with a valuable purpose: to provide a fixed location where a pen can be easily and conveniently stored. It has a strong adhesive backing that allows it to adhere to most surfaces and its unique design gives it the ability to securely hold a variety of pen sizes up to a standard sized Sharpie marker. **Additionally, Pen Pal’s design was perfected to hold a pen**

⁴⁰ Specimen at 7.

securely while at the same time allowing the pen to be easily inserted and removed from the holder.⁴¹

(emphasis added). Photos on Applicant's web page, shown below, display Applicant's holders on a flat surface, attached to a clipboard, and attached to a lanyard:



⁴¹ Feb. 3, 2022 Office Action at 9 (emphasis added).

⁴² *Id.*

Pen Pal is a very simple product with a valuable purpose: to provide a fixed location where a pen can be easily and conveniently stored. It has a strong adhesive backing that allows it to adhere to most surfaces and its unique design gives it the ability to securely hold a variety of pen sizes up to a standard sized Sharpie marker. Additionally, Pen Pal's design was perfected to hold a pen securely while at the same time allowing the pen to be easily inserted and removed from the holder.

Applicant asserts that the text from its own website does not “actually extol specific utilitarian advantages of the applied-for mark,” (4 TTABVUE 12), and that the first sentence “merely indicates that the product is ‘simple’ and that its purpose is to hold a pen.” (4 TTABVUE 12). Applicant further argues that its product design “does not claim any adhesive, and the pen holding capability is based on the contours of the inner surface which are expressly disclaimed by the applied-for mark.” (4 TTABVUE 12).

We find the text of Applicant’s specimen and the text shown on Applicant’s webpage stating that the design of Applicant’s product “was perfected to hold a pen securely while at the same time allowing the pen to be easily inserted and removed from the holder,” along with the photo on Applicant’s webpage displaying the holder attached to a lanyard worn around a person’s neck, tout a utilitarian advantage insofar as it pertains to the distance between the surfaces of the upper portions of Applicant’s holder without needing to consider whether the use of an adhesive is necessary for such an advantage. Thus, the second *Morton-Norwich* factor also weighs in favor of a finding of utilitarian functionality.

C. The Availability to Competitors of Functionally Equivalent Designs

“The effect on competition is the ‘crux’ of the determination of functionality.” *In re Cabot Corp.*, 15 USPQ2d 1224, 1227 (TTAB 1990). The Examining Attorney made of record the ’372 Patent (“Magnetic Holder For Pencils Or The Like”), the drawing of which is shown above in Part I of this opinion. But we do not find the ’372 Patent to be probative, inasmuch as it describes an “invention [that] relates to a magnetic pencil holder, or a holder for other slender objects, particularly intended for holding such objects on a base of ferrous material,”⁴³ and claims “a magnetic holder for a slender elongated article comprising a body of magnetized rubber-like material...”⁴⁴ (Examining Attorney’s Appeal Brief, 6 TTABVUE 7). Applicant’s Mark does not identify a magnetic pencil holder or “magnetized rubber-like material. In addition, Applicant’s product holds writing or cylindrical instruments of various sizes, not just “slender objects ... on a base of ferrous material.” Thus, the ’372 Patent is not a functionally equivalent design.

Even so, we need not consider other possible designs because as previously discussed, the rectangular base and exterior upper surfaces of Applicant’s holder make the holder’s design functional. *See TrafFix*, 58 USPQ2d at 1007 (“There is no need, furthermore, to engage ... in speculation about other design possibilities Here, the functionality of the spring design means that competitors need not explore

⁴³ Aug. 18, 2022 Final Office Action at 5.

⁴⁴ *See also id.*

whether other spring juxtapositions might be used.”). Therefore, we consider the third *Morton-Norwich* factor to be neutral.

D. Whether the Design Sought to be Registered Results from a Comparatively Simple or Inexpensive Method of Manufacture

In its August 3, 2022 Office Action response, Applicant states its product is manufactured using an injection molding process, and that competing products having an alternative design are produced using the same process.⁴⁵ Applicant maintains its product design “has no manufacturing advantage over alternative designs,”⁴⁶ and that there would be “virtually no difference in the cost or process of manufacturing a competing product.”⁴⁷ The Examining Attorney points to these same statements from Applicant’s August 3, 2022 Office Action response. (6 TTABVUE 9). Since there is no evidence of record demonstrating that the design sought to be registered is comparatively simple or inexpensive to manufacture, we consider the fourth *Morton-Norwich* factor to be neutral. *See Becton, Dickinson*, 102 USPQ2d at 1376 (Board did not err in refusing to weigh the fourth factor where there was little evidence of record to establish whether the design at issue resulted from a comparatively simple or inexpensive method of manufacture).

⁴⁵ Aug. 3, 2022 ROA at 134.

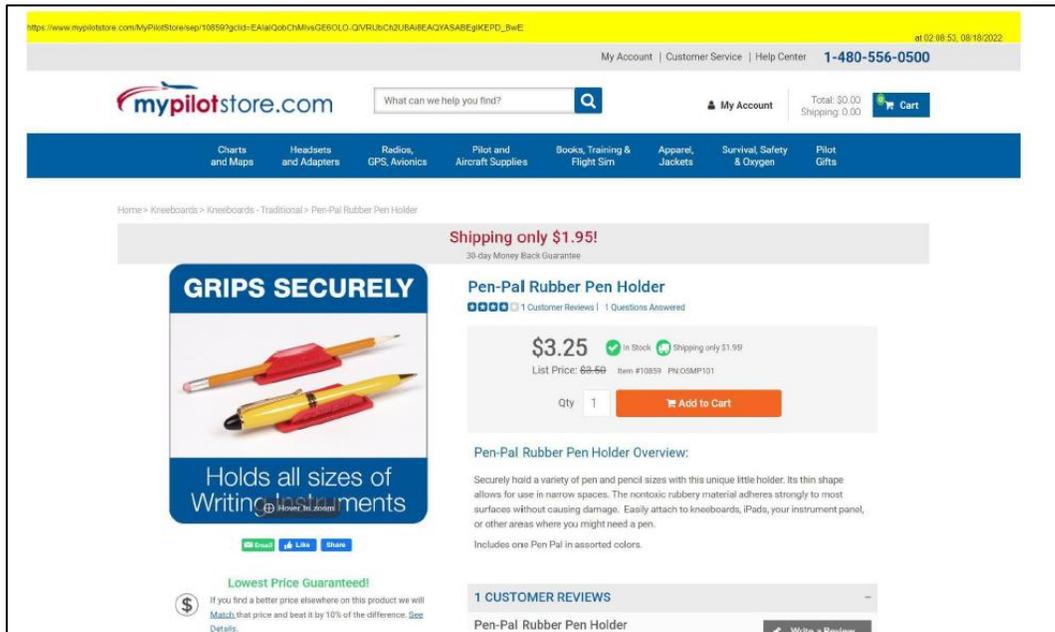
⁴⁶ *Id.*

⁴⁷ *Id.*

E. Third-Party Advertising

As discussed previously, the *Morton-Norwich* factors are not exclusive. See *Poly- Am.*, 124 USPQ2d at 1519 (“Petitioner need not present evidence fitting within all four categories in *Morton-Norwich*.”). The determination of functionality is a question of fact and depends on the totality of the evidence. See *Valu Eng’g*, 61 USPQ2d at 1424.

The Examining Attorney made of record the following evidence from what appears to be a third-party webpage, mypilotstore.com:



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⁴⁸ Aug. 18, 2022 Final Office Action at 17 (page 1) (cropped image).

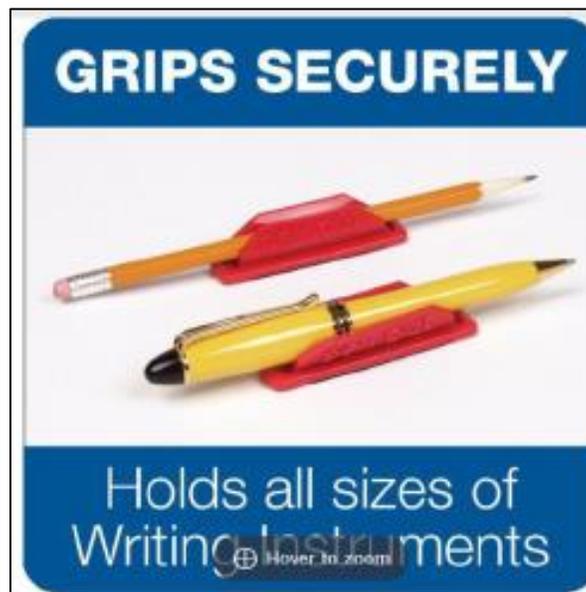
Pen-Pal Rubber Pen Holder Overview:

Securely hold a variety of pen and pencil sizes with this unique little holder. Its thin shape allows for use in narrow spaces. The nontoxic rubbery material adheres strongly to most surfaces without causing damage. Easily attach to kneeboards, iPads, your instrument panel, or other areas where you might need a pen.

For ease of reference, the “Pen-Pal Rubber Pen Holder Overview” on the webpage states, in relevant part:

Securely hold a variety of pen and pencil sizes with this unique little holder. Its thin shape allows for use in narrow spaces. The nontoxic rubbery material adheres strongly to most surfaces without causing damage. Easily attach to kneeboards, iPads, your instrument panel, or other areas where you might need a pen.⁴⁹

Shown below is a cropped image from mypilotstore.com of two of Applicant’s holders on a flat surface, one with a pencil and one with a pen, framed by the words “Grips Securely” and “Holds all sizes of Writing Instruments.”⁵⁰



⁴⁹ *Id.*

⁵⁰ *Id.*

Applicant objects to the mypilotstore.com evidence, arguing that the webpage identifies the general shape of the holder “which is dictated by the shape of the writing utensils the product is designed to hold”; points out the “nontoxic rubbery material” of the holder, which is not identified in the description of the mark; and identifies places where the holder may be used, which also is not identified in the description of the mark. (4 TTABVUE 13).

We find the language in the mypilotstore.com advertisement, specifically, “[h]olds all sizes of Writing Instruments,” and “[s]ecurely hold a variety of pen and pencil sizes with this unique little holder. Its thin shape allows for use in narrow spaces,” touts utilitarian advantages of the holder: the ability to accommodate writing instruments of various diameters, the ability to fit in narrow spaces, and the ability of the holder to keep a writing instrument in place and not roll away. All of these aspects make Applicant’s product design functionally superior. *See, e.g., Brunswick*, 32 USPQ2d at 1124 (refusal to register as functional the color black for outboard motors affirmed; the color black was found necessary for coordinating with the wide variety of boat colors, and for “decreasing apparent object size”). This evidence also weighs in favor of a finding of utilitarian functionality.

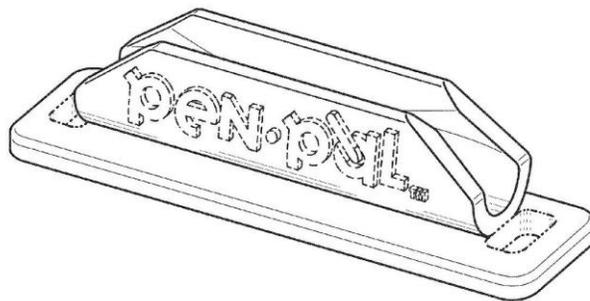
F. Applicant’s Design Patents

Finally, we consider Applicant’s design patents. Applicant contends there is “strong presumptive evidence of non-functionality under *Morton-Norwich*,” arguing that the features of its proposed mark are “identically disclosed and claimed” in two of its design patents, ’414 and ’449. (4 TTABVUE 9-10). The Examining Attorney

counters that the drawings in the '414 and '449 patents differ in appearance from Applicant's Mark, because in both patents "the upper-edge is depicted at different angles for both designs." (6 TTABVUE 5).

"Our law recognizes that the existence of a design patent for the **very design** for which trademark protection is sought 'presumptively ... indicates that the design is not *de jure* functional.'" *Becton, Dickinson*, 102 USPQ2d at 1377 (quoting *Morton-Norwich*, 213 USPQ at 17 n.3) (italics in original; emphasis added). However, ownership of a design patent does not, in itself, establish that a product feature is non-functional; such ownership can be outweighed by other evidence supporting a functionality determination. *See Becton, Dickinson*, 102 USPQ2d at 1377; *In re R.M. Smith*, 222 USPQ at 3; *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *6-7 (TTAB 2019); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); *In re Am. Nat'l Can Co.*, 41 USPQ2d 1841, 1843 (TTAB 1997).

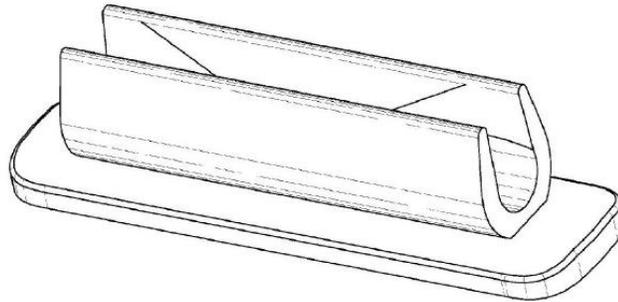
The drawing of Applicant's '414 Patent is reproduced below:



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⁵¹ Aug. 3, 2022 ROA at 22, Fig. 1.

The drawing of Applicant's '449 Patent is reproduced below:



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Applicant's Mark "does not comprise the interior surface of the upper portion of the holder or the end portions of the slot where a pen or pencil may be inserted into the holder." (4 TTABVUE 6). But the interior surface and upper edge of both the '414 and '449 patents, shown above, are not excluded from either product design. Consequently, we find this evidence is not probative of non-functionality, since the '414 and '449 design patents do not disclose the "very design for which trademark protection is sought." *Becton, Dickinson*, 102 USPQ2d at 1377. For the same reason, we also find Applicant's '743 and '382 patents, which disclose different shapes, are not probative of non-functionality.

IV. Conclusion as to Functionality

When applying the *Morton-Norwich* factors to the application, we find, under the first and second factors, the evidence of record establishes a prima facie case of functionality in Applicant's proposed product design mark. Applicant has failed to rebut this prima facie case with competent evidence. *See In re R.M. Smith*, 222 USPQ

⁵² *Id.* at 25.

at 3 (where the Office's attorney established a prima facie case of de jure functionality, applicant, in order to prevail, must rebut the prima facie case with competent evidence) (citing *In re Teledyne Indus.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982)). We find the third and fourth *Morton-Norwich* factors to be neutral. In addition, the third-party advertising evidence of record supports a finding of utilitarian functionality, and we find Applicant's design patent registrations are not probative of non-functionality. Accordingly, weighing and balancing all of the evidence of record, we conclude that Applicant's Mark, as a whole, is functional under Section 2(e)(5) of the Trademark Act. See *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912, 1928, 1930-31 (TTAB 2011) (Board balanced and weighed *Morton-Norwich* factors where functionality of product configuration was the asserted ground for cancellation).

V. More Accurate Description Requirement

Now we consider the Examining Attorney's requirement for a more accurate description of Applicant's Mark. Applicant's Amended Description, which is the operative description, reads as follows:

The mark consists of a three-dimensional configuration of specific design features of a pen or pencil holder; The applied-for mark comprises the exterior surface of an upper portion of the holder; The applied-for mark further comprises the rectangular base of the holder; The applied-for mark does not comprise the interior surface of the upper portion of the holder or the end portions of the slot where a pen or pencil may be inserted into the holder.⁵³

⁵³ Aug. 18, 2022 Final Office Action at 6.

The Examining Attorney argues that Applicant's Amended Description is insufficient because Applicant "failed to include all elements of the mark in their amended description." (6 TTABVUE 9). See Trademark Rules §§ 2.37, 2.52(b)(2) and (b)(4); 37 C.F.R. §§ 2.37, 2.52(b)(2) and (b)(4); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983) (examining attorney should have required that applicant amend the description of its product design, which was found to be functional, where the claimed distinctive feature of the design was represented in the drawing but not identified in the description); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1202.02(c)(ii) ("Descriptions of Trade Dress Marks Required") (July 2022).

The Examining Attorney proposes the following description:

The mark consists of a three-dimensional configuration of a pen or pencil holder. The holder consists of a rectangular curved-edge base with an interior middle line. Above the base sits a concave grip or sleeve that is smaller than the base where a pen or pencil may be inserted. The dotted lines depicting the interior portion of the grip and the upper sloping sides of the grip are not claimed as a feature of the mark.⁵⁴

TMEP § 808.02 ("Description Must Be Accurate and Concise") states that "the description should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission. ... The description should describe all *significant* aspects of the mark, including both literal elements and design elements. Insignificant features need not be included in a description." (italics in original).

⁵⁴ Aug. 18, 2022 Final Office Action at 6.

Under this guidance, we find Applicant's Amended Description fails to comply with Trademark Rule 2.37 and the corresponding guidelines provided in the TMEP. While the Amended Description does limit the three-dimensional configuration to "a pen or pencil holder," Applicant fails to precisely describe what exactly is the "exterior surface of an upper portion of the holder"; it is difficult to determine where, specifically, the "upper portion of the holder" begins and ends. Likewise, it is difficult to determine where the "interior surface of the upper portion of the holder" begins and ends. Applicant's Amended Description also fails to describe, with precision, the grip and interior sleeve of the holder, as well as the rectangular base of the holder, which appears to be divided into two sections in the drawing of Applicant's Mark. As a result, we affirm the more accurate description requirement.

Decision: The refusal to register Applicant's Mark on the ground of utilitarian functionality is affirmed. The Examining Attorney's requirement for a more accurate description of the mark also is affirmed.